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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,818	07/09/2001	Kazunori Suzuki	SAT 163	9649
23995	7590	03/29/2007		
RABIN & Berdo, PC 1101 14TH STREET, NW SUITE 500 WASHINGTON, DC 20005			EXAMINER FELTEN, DANIEL S	
			ART UNIT	PAPER NUMBER
			3693	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/29/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/899,818		SUZUKI ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Daniel S. Felten		3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. Receipt of applicant's January 03, 2007 response to the restriction requirement set forth in the November 30, 2007 Office Action is acknowledged. Upon further consideration, the following election of species is requested.

#### ***Specification***

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no antecedent basis for a "payment system". Is the applicant calling the e-commerce system 100 (see fig. 1) the payment system or is the payment server 76 considered the payment system?

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The negative limitation wherein the user terminal has no function of transferring said payment

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information to said wallet server is not described in the applicant's specification, or at least describe in such a way as to convey support from the specification [see MPEP 2173.05(i)].

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-14 and 17 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the relay server device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative relay server device. The applicant in claim 1, limitation recites a relay server for use in a payment system, but then provides features not consistent with the features of the relay server 40 (figs. 1 & 2) (see applicant's specification, page 11, lines 13-22; and page 13, lines 17 to page 18, line 14), but more applicable to the payment system/e-commerce system 100 for which the relay server is a component (see fig. 1). Claims 2, 3, 8-14 and 17 are therefore not a part of the relay server as disclosed in the applicant's specification (see figs. 1 & 2). Thus claims 1, 4-7 are the only features related to the relay server (see fig. 2).

7. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex*

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*parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation or "A relay server for use in a payment system that includes a user terminal able to be connected to a network and during a payment procedure...a shop server connected to a network...a payment server connected to a network...a wallet server..." and the claim also recites "wherein said relay server comprises a redirecting section..." which is the narrower statement of the range/limitation. Also it seems that the applicant is claiming the e-commerce system 100, or the entire system (see fig. 1), instead of claiming features disclosed in applicant's specification concerning the relay server 40 (see figs. 1 & 2). Thus the much broader limitation of the e-commerce system and then the more narrow claim language of the relay server found in the second limitation makes claim 1 indefinite.

8. Claims 1-14 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "wherein said relay server..." provides claim language that suggests or makes optional but does not require the steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation [see MPEP 2111.01 & 2106]. The limitation of "...able to be " or "is able" is also considered indefinite

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because the phrase implies that the object has the *potential* of performing the function. Having the potential to perform a function does not convey that the object is *required* to perform the function. Thus the examiner is can not ascertain whether the user terminal, in claim 1, is connected to a network, or in claim 3, the user terminal has direct communication with shop server.

In claim 4, “a converting unit to select at least one predetermined information item out of said information for said payment procedure *based on a receiving capability of said user terminal*, to produce summarized information using at least one selected information item...” is indefinite because the phrase, “said payment procedure *based on a receiving capability* of the user terminal” does not convey that the converting unit in the limitation is required to select at least one predetermined information item but only has the potential of performing this function.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kerkdijk in view of Vazvan (WO 97/45814).

Kerkdijk discloses a relay server 14 (Agent Negotiation Server, "ANS") for use in a payment system (see fig. 1) that includes a user terminal 2 (customer PC) able to be connected to a network 1 (Internet) and used during a payment procedure for a transaction on the network between a shop (merchant) and a user (customer) using a user terminal (see Kerkdijk, column 2, lines 22-25; and column 2 line 62 to column 3, line 27), a shop server 3 (merchant servers) connected to the network and used to produce payment information including an amount to be paid by said user in said transaction (see column 2, lines 22-25), a payment server 5 connected to the network and used to perform payment processing for said transaction between said user and said shop (see Kerkdijk, column 2, lines 26+), and a wallet server 9 (Third party Server) connected to said network and having authentication information of said user required for said payment server for said payment processing (see column 2, lines 38+),

Wherein the relay server 14 comprising redirecting section which receives from said user terminal procedure requesting information to prompt said shop to take said payment procedure

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and transfers said procedure requesting information to said shop server (see column 2, line 47 to column 3, line 27),

and which receives said payment information from shop server and transfers said payment information to the wallet server (see column 2, line 47 to column 3, line 27; and column 3, line 62 to column 4, line 7).

Kerkdijk fails to disclose that the user terminal comprises a portable cellular phone. Vazan discloses a remote purchase payment system that uses a wireless/cellular terminal that allows a user to perform remote purchases and bill payment transactions over a network (see Vazan, fig. 1, Abstract, and page 4, line 21 to page 6, line 8). It would have been obvious for an artisan at the time of the invention of Kerkdijk to substitute the Mobile Wallet-Phone ("MWP") in Vazan for the customer terminal 2 because an artisan would have considered the MWP as an art recognized equivalent to the customer terminal inasmuch as both are used to perform transactions via a network. An artisan would be motivated to substitute the MWP for the customer terminal so as to conveniently allow the customer to complete and/or conduct transactions/exchanges remotely without having to be in a stationary location. Thus the ability to physically conduct secure transactions in any location over a multimedia network without being tied to a stationary computer/terminal would provide greater accessibility to the Kerkdijk system and thus would be an obvious expedient well within the ordinary skill of the art.



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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Daniel S Felten  
Examiner  
Art Unit 3693

DSF  
3/19/2007